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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,128	12/03/2003	Juliana Parente	006943.00193	4758
66811 7590 04/19/2007 BANNER & WITCOFF, LTD. and ATTORNEYS FOR CLIENT NO. 006943 10 SOUTH WACKER DR. SUITE 3000 CHICAGO, IL 60606			EXAMINER PRATT, HELEN F	
			ART UNIT	PAPER NUMBER
			1761	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/19/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/727,128	<b>Applicant(s)</b> PARENTE ET AL.	
	<b>Examiner</b> Helen F. Pratt	<b>Art Unit</b> 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-28 is/are allowed.
- 6) ☒ Claim(s) 39-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer et al. (5,474,793).

Meyer et al. disclose a process as in claims 31-35 for making a calcium supplemented not-from concentrate (NFC) fruit juice by adding calcium hydroxide to circulating acidified NFC juice stream, which contains citric and malic acids (abstract, col. 10, lines 21-34, col. 6, lines 40-45). The above claims require a particular method of making the product. The fact that the procedures of the reference are different than that of applicant is not a sufficient reason for allowing the product-by-process claims since the patentability of such claims is based upon the product formed and not the method by which it was produced. See *In re Thorpe* 227 USPQ 964. The burden is upon applicant to submit objective evidence to support their position as to the product-by-process claims. See *Ex parte Jungfer* 18 USPQ 2D 1796. Claim 31 further requires that 90% of the calcium remain solubilized for at least five weeks. As the claimed process has been shown, it is seen that the calcium would have been solubilized for this amount of time. Also, applicants' specification discloses on page 15, para. 0056 that the solubility of the calcium product is 90% and on page 19, para.0067, ex. 5 that the

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calcium solubility is similar to that of CCM (Meyer et al. reference). Nothing is seen that the soluble calcium citrate malate of Meyer et al. would not have been stable for as long as claimed since it has the same solubility. Therefore, it would have been obvious to make a product, which contains solubilized calcium, which is stable as shown by Meyer et al.

The claimed amount of solubilized calcium is disclosed as in Meyer et al. as in claim 32 –35 (abstract). The limitations of claims 36-37 have been disclosed above and are obvious for those reasons. Therefore, it would have been obvious to make the claimed product as shown by the combined references.

Claims 29, 30, 38-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer et al. as applied to the above claims, and further in view of Chang et al. (7,052,725) and Kaji H (JP 4008767 A).

Claims 29 and 30 are product by process claims requiring particular amounts of the daily value of calcium and weights of calcium. Chang et al. disclose the use of various amounts of calcium in 1 liter of beverage (col. 8, lines 14-50). As it is known how to fortify beverages with calcium, it would have been within the skill of the ordinary worker to fortify with whatever amount was required as shown by Chang et al. Meyer et al. disclose the use of NFC juices containing from 0.05 to .26% calcium (abstract). Also Kaji H discloses making a soft drink containing 3 parts of a calcium salt made from a mixture of calcium citrate, malate and lactate (abstract). The fact that the procedures of the reference are different than that of applicant is not a sufficient reason for allowing the product-by-process claims since the patentability of such claims is

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based upon the product formed and not the method by which it was produced. See *In re Thorpe* 227 USPQ 964. The burden is upon applicant to submit objective evidence to support their position as to the product-by-process claims. See *Ex parte Jungfer* 18 USPQ 2D 1796). Therefore, it would have been obvious to add within the claimed amounts of calcium to beverage products.

Claims 38, 40-47 further require various amounts of calcium, which have been discussed above and are obvious for those reasons.

Claim 39 contains 0.1 % calcium as disclosed by Meyer et al in a NFC juice (abstract). Therefore, it would have been obvious to make a product containing 0.1% calcium.

#### ***Allowable Subject Matter***

Claims 1-28 are free of the prior art.

#### **ARGUMENTS**

Applicant's arguments filed 3-12-07 have been fully considered but they are not persuasive. Applicants argue that the claims are allowable for the reasons set forth above. This would be for the reasons the process claims were allowable. However, as in *In re Thorpe supra*, the composition can be made by a different process. The composition has been shown by the references cited above, and nothing has been shown that the particular amounts are not within the claimed ranges. No claim is seen to metallic or bitterness characteristics as argued.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 571-272-1404. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hp 4-17-07

  
HELEN PRATT  
PRIMARY EXAMINER